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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,499	08/28/2003	Wayne Yingling	DTL 8464US	6968

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POLSTER, LIEDER, WOODRUFF & LUCCHESI
12412 POWERS COURT DRIVE SUITE 200
ST. LOUIS, MO 63131-3615

EXAMINER

SMITHERS, MATTHEW

ART UNIT PAPER NUMBER

2137

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/650,499

Applicant(s)

YINGLING, WAYNE

Examiner

Matthew B. Smithers

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 and 16 is/are allowed.
- 6) ☒ Claim(s) 1,6,7,11-14 and 17-20 is/are rejected.
- 7) ☒ Claim(s) 2-5 and 8-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 5 depends from itself. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 11-14 and 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 11-14 and 17-20 provides for the use of a computer program, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-14 and 17-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 11 and 17 each recite a method implemented as a computer program. First, computer programs are not a series of steps or acts to a process (i.e. method) nor are they a combination of chemical compounds to be a composition of matter. Also, computer programs lack the necessary physical article or objects to constitute a machine or a manufacture within the meaning of 101. Therefore, computer programs are non-statutory as they fail to fall within one of the four statutory classes of an invention described above. Dependent claims 12-14 and 18-20 fail to overcome the deficiencies of their respective base claims and are therefore rejected based on a similar rationale.

Claims 11-14 and 17-20 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent 6,615,349 granted to Hair and further in view of US patent 6,976,165 granted to Carpentier et al.

Regarding claims 1, 6 and 7, Hair provides a system where an encrypted transmission of computer files from a serving device to a client device automatically invokes functionality of an operating system at the client device (see Abstract; column 8, lines 24-57). The serving and client devices use a public key infrastructure to encrypt and transmit the computer file (see column 13, line 55 to column 16, line 25). Hair further discloses the use of an encrypting system where a randomly generated secret key is used to encrypt both the computer file and the key associated with the file (see column 16, lines 26-48). Hair fails to specifically teach inserting the key into the contents of the file. Carpentier teaches a system for transferring an encrypted file where the file is encrypted using an intrinsic unique identifier (secret key) that is made a part of the content file (see column 7, lines 28-42; column 8, lines 11-28 and Figures 2, 4, 9A, 9B, and 10). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Carpentier's system for secure storage and transfer of content information with Hair's system for transferring an encrypted file for the purpose of insuring the integrity of the contents of the file have not been tampered with during transmission, storage or utilization of the file (see Carpentier; column 6, line 62 to column 7, line 6). One of ordinary skill in the art would have been motivated to combine the two in order to protect the system file from being compromised by a hacker.

Allowable Subject Matter

Claims 15 and 16 are allowed.

The following is an examiner's statement of reasons for allowance: The present invention is directed to a method and system for preventing unauthorized access and damage to files used to perform a function on a computer. Independent claim 15 recited the uniquely distinct features of "selecting an program file run by the computer; randomly inserting a first key into the contents of the file; encrypting the resulting file using a second, separate key; decrypting the encrypted file prior to its subsequent use, the file being decrypted using the second key and the decrypted file now being examined for the first key embedded therein; and, validating the decrypted file for use by the computer if the first key is found in the decrypted file, but rejecting the decrypted file for use by the computer if the first key is not found because failure to find the first key in the decrypted file is evidence the file has been hacked." The closest prior arts, Hair (US 6,615,349) and Carpentier (US 6,976,165), in combination disclose a system for maintaining the integrity of a file transferred from one device to another fails to anticipate or render the above underlined limitations obvious.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claims 2-5 and 8-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

With respect to claims 2-5 and 8, the cited prior art fails to specifically teach the key is randomly inserted into the contents of the file, the encryption key is a second key, separate from the first said key; decrypting the encrypted file using the second key; and, scanning the decrypted file to locate the first said key, the decrypted file then being validated for use to perform the function for which it is used if the first said key is found, but the decrypted file not being validated for use if the first said key is not found which is an indication that the file has been altered without authorization; storing a copy of the file after it is encrypted using the second key and replacing the original file with the stored copy thereof if the first said key cannot be found after the file is decrypted, the replaced copy of the file then being used to perform the desired function.

With respect to claims 9 and 10, the cited prior art fails to specifically teach the second key is a key separate from the first key and storing a copy of the file after it is encrypted using the second key and replacing the original file with the stored copy thereof if the first said key cannot be found after the file is decrypted, the replaced copy of the file then being used to perform the desired function.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Lim et al (US 20030126434) discloses a file security system using a security class and an encryption key.

B. Rollins (US 20020141588) discloses a system for securing and encrypting files for transfer to a client system.

C. Redlich et al (US 7,146,644) discloses a security system for securing data against electronic attacks.

D. Goodman et al (US 7,146,640) discloses a personal computer Internet security system for securing downloaded files from malicious code.

E. Worely, Jr. et al (US 7,073,059) discloses a secure platform for operating systems.

F. Weicher (US 7,069,591) discloses a system for encrypting data files of application programs.

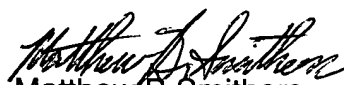
G. Sueyoshi (US 6,889,378) discloses a method where verification of tasks and a computer operating system are performed in order to permit execution of services.

H. Harrison (US 5,870,468) discloses a method for protecting selected files in a computer system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew B. Smithers whose telephone number is (571) 272-3876. The examiner can normally be reached on Monday-Friday (8:00-4:30) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel L. Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Matthew B Smithers
Primary Examiner
Art Unit 2137